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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/409,680	09/30/99	NAKANISHI	M 0234-0372P

IM31/0312  
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EXAMINER

CHEA, T

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/409,680

Applicant(s)

NAKANISHI ET AL.

Examiner

Thori Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-12, 17-21, 24-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('331).

The '331 patent discloses a submicron particles of material such as pigment useful in paints or a compound useful in imaging element which comprises milling the agent in the presence of milling media having mean particle size of less than about 100 microns (abstract). Any suitable compounds useful in the imaging element and the use thereof in the photographic element is described from column 11 to column 35. Czekai may not produce the submicron particles of compound useful in the imaging element having steps presented in the claimed invention. Czeck discloses solid particle having size and composition similar to that of the claimed invention. Thus, the claimed invention is either anticipated by or would have been found obvious over Czeck. "E)ven though product-by-process claims are limited by and defined by the process, determination of

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patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process. *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

3. Claims 7-12, 17-21, 24-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('705).

The '705 patent discloses particle compound useful in imaging elements which are milled using a milling media comprising polymeric resin. The use of polymeric milling media permits the production of particles having an average particle size less than 1 microns (abstract). The compound useful in imaging element in solid particle forms and the use thereof in a photographic material are described in columns 9-31. Czeck discloses solid particle having size and composition similar to that of the claimed invention. Thus, the claimed invention is either anticipated by or would have been found obvious over Czeck. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process. *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). "

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4. Claims 13-16, 22-23, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '333 patent and '705 patent as applied to claims 7-12, 17-21, 24-18 above, and further in view of Lobo et al (Lobo).

Lobo discloses the use of an ionic polymer within the scope of the claimed invention to create a small particle photographic dispersion of PUMs without increasing the level of surface active material or hydrophilic colloid, without increasing the homogenizing temperature and without the use of auxiliary solvent. Note to the problem to be solved in column 4, lines 10-15, and the polymer in columns 11-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer taught in Lobo in the process for preparing a solid fine particle taught in the '333 patent or '05 patent for same reason taught in Lobo, and thereby provide a material as claimed.

5. Claims 12, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '333 patent and '705 patent as applied to claims 7-12, 17-21, 24-18 above, and further in view of Scaringe et al (Scaringe).

The compounds claimed in claim 12, 21, 28 have known as photographic filter dyes and taught in Scaringe in column 7, lines 47-68. It would have obvious to form a solid fine solid particle of a known photographic useful group including the filter dyes taught in Scaringe, and thereby provide a material as claimed.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Czekai et al ('705) in combination with Canepa et al (Canepa), Bishop et al (Bishop) or Inkyo et al (Inkyo).

The '705 discloses particle compound useful in imaging elements which are milled using a milling media comprising polymeric resin. The use of polymeric milling media permits the production of particles having an average particle size less than 1 microns (abstract). The polymeric resin using as milling media include polyurethane, polytetrafluoroethylene or high density polyethylene (column 3, lines 25-53). Milling can take place in any suitable milling mill includes a ball mills , a media ball mill or bead mill (column 4, lines 35-41). The compound useful in imaging element in solid particle forms and the use thereof in a photographic material are described in columns 9-31. Canepa, Bishop and Inkyo each discloses an agitating ball mill apparatus similar to that of the apparatus using in the claimed process. This apparatus is used in the process for grinding solid particle or mixing photographic dispersion. Note to Bishop in column 1, lines 5-10, and the apparatus shown in Bishop in sheets 1-4; Canepa, Sheets 1-6; and Inkyo, sheets 1-9. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known mills known in the art including those disclosed in Bishop, Canepa, or Inkyo in the process for forming a solid particles of compound useful in imaging element taught in the '705 to provide a process as claimed. The diverse steps present in the claims are inherent to the apparatus taught in Bishop, Canepa or Inkyo because of its similarity to the apparatus used in the present invention.

### ***Response to Arguments***

7. Applicant's arguments filed December 21, 2000 have been fully considered but they are not persuasive. The applicants' argument with respect to claims 7-12, 17-21 and 24-28 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC

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103(a) as being obvious over Czekai ('331) or Czekai et al ('705) is based on the process for forming photographic solid fine-grain dispersion. The applicants provide a lengthy discussion about the difference between the media used in the present invention and that of the '331 or '705 patent. However, the final product is not the media, but the photographic solid fine-grain dispersion. The media may remain in the chamber, while the photographic solid fine-grain may be removed for use in photographic material. The fine-grain dispersion of the claimed invention is same or similar to that of '331 or '705 patent.

The applicants further argue that the Declaration under 37 CFR 1.132 filed December 21, 2000 in Table 1 shows average grain size of dispersion of '331 and '705 is 2 micron and that of the invention is 0.29 micron.

The argument is not persuasive. The average grain size of 0.29 micron is presented in any claims, and average grain size of dispersion may encompass the size of 2 micron in sample S-19 and S-20 of the Declaration. Thus, argument with respect to the average grain size of dispersion is irrelevant to the claims.

The argument with respect to the rejection of claimed process in claims 1-6 under 35 USC 103(a) is not persuasive for the reason set forth above. The media having specific density such as polyurethane, polytetrafluoroethylene or high density polyethylene has been known in the '705 patent in column 3 lines 25-45. The use of this polymeric media produce a particle of compound useful in imaging element of less than 100 micron which is within the meaning of "fine grain dispersion" presented in the claimed invention. The applicants' argument is based on the inherent property of the polymeric

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media. However, the polymeric media used in the present invention and that of the prior art are the same or similar. Accordingly, the arguments presented in the response is not persuasive, and the rejections set forth above are maintained.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3599 for regular communications and (703)305-3599 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Thorl Chea  
Primary Examiner  
Art Unit 1752

tchea   
March 8, 2001